The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HEIKKI ILVESPAA

Appeal No. 2000-1692
Reissue Application 08/861,231

ON BRIEF

Before FRANKFORT, BARRETT, and NASE, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

REMAND TO THE EXAMINER

This application is remanded to the examiner under the authority provided us by 37 CFR § 1.196(a) and MPEP § 1211 for action in accordance with the following comments.

The appeal involves claims 26, 28 through 34 and 36 through 41 of this reissue application. Claims 1 through 25 stand allowed.

ISSUE 1: In making the rejection of claims 26, 28 through 34 and 36 through 41 under "35 U.S.C. 351 [sic, 35 U.S.C. § 251]" based on "an improper recapture of claimed subject matter which broadens the scope of the claims of the original patent upon which the present reissue is based" (final rejection, Paper No. 12), the examiner has apparently merely compared the present reissue claims to the claims of the issued patent to partially ascertain what limitations of the issued claims are not present in the reissue claims. The examiner has not even attempted to compare the reissue claims to the actual surrendered subject matter (e.g., claims 1, 18 and 22 as seen in Paper No. 8 of Application No. 07/808,161 and claim 8 as shown in Paper No. 11 therein) to determine if the reissue claims are as broad as or broader than the surrendered subject matter and, if so, exactly how they are broader (i.e., whether the broader aspects are germane to a prior art rejection). Nor has the examiner fully and appropriately performed a balancing of the broader aspects with the narrower aspects of the reissue claims to ascertain whether or not the claims on appeal may avoid the effect of the Recapture rule. At a minimum, the examiner must perform the above-noted analysis of the reissue claims and the surrendered subject matter in order to properly establish that the Recapture

rule applies. For guidance, the examiner should see Ball Corp. v. United States, 729 F.2d 1429, 221 USPQ 289 (Fed. Cir. 1984); Mentor Corp. v. Coloplast Inc., 998 F.2d 992, 27 USPQ2d 1521 (Fed. Cir. 1993); In re Clement, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); and Hester Industries Inc. v. Stein Inc., 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998).

ISSUE 2: The examiner should consider whether the subject matter now set forth in claims 26, 28 through 34 and 36 through 41 of this reissue application finds proper support under 35 U.S.C. § 112, first paragraph, in the application as originally filed. For example, claim 26 sets forth a method that involves asymmetrically drying a paper web by passing the paper web through a plurality of top-felted single-tier normal dryer groups, each of which normal dryer groups includes certain structural features, and subsequently applying sufficient heat and moisture to the asymmetrically dried paper web to relax curl-inducing stresses in the fiber mesh of the paper web, to thereby control curling of the web. Similarly, claim 34 sets forth a plurality of top-felted single-tier normal dryer groups that asymmetrically dry a paper web and a device for applying heat and

moisture to the asymmetrically dried paper web for relaxing said stresses and thereby controlling curling of the web, with claim 36 requiring that the device for applying heat and moisture be "disposed immediately downstream of said plurality of normal dryer groups." We do not readily see that the particularly claimed arrangement of a plurality of top-felted single-tier normal dryer groups has been described in the application as filed or, more particularly, that the arrangement of a plurality of top-felted single-tier normal dryer groups and a device for applying heat and moisture to the paper web exiting therefrom (i.e., subsequent to the asymmetric drying or immediately downstream of the normal dryer groups) has been described. The particular arrangement set forth in claims 26, 28 through 34 and 36 through 41 on appeal is also clearly not shown in the drawings (37 CFR § 1.83(a)).

ISSUE 3: The examiner should consider whether a prior art rejection of claims 26, 28 through 34 and 36 through 41 would be appropriate. In this regard, the examiner should consider appellants' disclosure in the "Background" section of the application that paper making machines that have single-wire draws in a drying section with what are apparently normal dryer

groups allows asymmetric drying of the paper web in the thickness direction of the web because the drying effect is applied more extensively to the face of the paper web that reaches direct contact with the heated drying cylinders (reissue application, page 4). In addition, the examiner should consider the significance of appellants' disclosure in the "Background" section of steam spraying of a paper web during calendaring so as to relax stresses in the fibers of the paper web by the effect of heat and moisture, especially in relation to broad claim 34 and claim 26 on appeal if such calendaring and steam spraying takes place subsequent to drying of the paper web, as this section of the specification implies. Appellants' disclaimer (reissue application, page 4) that, "in the calendaring stage, it is no longer possible to sufficiently eliminate the tendencies of curling of paper in all cases in an efficient manner" (emphasis added), does not appear to avoid the broad language of claim 34 on appeal, or claim 26 wherein the applying of heat and moisture is said to be subsequent to the drying section and for controlling, not necessarily eliminating, curling of the paper web. The examiner should also evaluate any other relevant prior art he/she is aware of in determining if the claims on appeal are patentable or not.

This application, by virtue of its "special" status, requires an immediate action, MPEP 708.01(d). It is important that the Board be informed promptly of any action affecting the appeal in this case.

REMANDED

Charles E. Frankfort
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